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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,985	05/19/2000	Dana W. Wolcott	80724PF-P	9582

1333 7590 07/06/2005

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EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,985

Applicant(s)

WOLCOTT ET AL.

Examiner

Timothy M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Final Office Action is responsive to the communication mailed February 24, 2005.

Drawings

The drawings submitted with Applicants' communication have been received. The drawings have been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 8, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ricoh" ("Ricoh to Bundle Club Photo Internet-based Photo Sharing Software with New 2-Megapixel Digital Camera" Business Wire (June 8, 1999)) in view of Cameraworld¹ and Safai et al. (US 6,167,469).

Applicant's invention is a method and system for providing photographic products and/or services comprising choosing a camera from a selection of cameras, selecting a service plan or product from a menu, associating the selected camera with the selected plan or product to create an account, and entering the account into a database to maintain a record of products or services to be provided in accordance with the selected plan.

Ricoh is evidence that Applicant's method and system were publicly known, and in use, before the date of invention. Ricoh expressly discloses selecting a camera (p. 1, lines 18-20), associating the selected camera with a service plan to create an online account (p. 1,

¹ <http://web.archive.org/web/19970414000034/http://www.cameraworld.com/index.html>

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lines 5-6; and p. 2, lines 2-4), and entering account information into a database to maintain a record of products or services to be provided (p. 1, line 8).

Note that the attached "Club Photo" Web pages serve as extrinsic evidence that Ricoh relied on the claimed selecting "from a menu of photographic product and/or photographic service plans" (e.g. claim 1). Ricoh states that the service that is packaged with its camera is provided through a "Club Photo" membership. The attached Club Photo Web pages show that the service mentioned in Ricoh required members to choose between a standard and upgraded membership. Thus, Applicants' selecting "from a menu of photographic product and/or photographic service plans" was known and in public use as part of Ricoh's method.

Ricoh and Club Photo do not establish that selecting a camera from "among a selection of cameras" (e.g. claim 1) was publicly known and/or used. However, Cameraworld shows that at the time of Applicant's invention, the Internet was being used to offer consumers an online camera catalog (i.e. a selection of cameras). Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Ricoh to include Cameraworld's online selection of cameras. This combination would allow Ricoh's to market its camera over the Internet.

Note that the Club Photo Web page with the heading "FREE Membership for Everyone" serves as extrinsic evidence that the following were publicly known and/or used:

storing a digital record for a predetermined period of time (*n.b.*: Club Photo recycles Web pages after a predetermined period of time); and

providing an image product (*n.b.*: Club Photo sells "photo finishing products personalized with your favorite photots").

Ricoh discloses updating the product/service plan account as claimed. This is because as users upload pictures to the Club Photo server, their personalized Web pages (i.e. Web accounts) are updated to reflect the change.

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Ricoh and Cameraworld do not expressly teach automatically access a computer database when images are received from a digital camera. However, Safai et al. overcome this deficiency by disclosing the automatic distribution of digital images to a remote server (see e.g. col. 13, lines 39-46; and col. 14, lines 9-24). Note that Safai et al. suggest combining this automatic distribution feature with the teachings of Ricoh and Cameraworld in that Safai et al. disclose distributing digital images in connection with the maintenance of a photo album. Therefore, at the time of Applicants' invention, it would have been obvious to modify Ricoh and Cameraworld to include the teachings of Safai et al.

Claims 14, 15, 24 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ricoh" ("Ricoh to Bundle Club Photo Internet-based Photo Sharing Software with New 2-Megapixel Digital Camera" Business Wire (June 8, 1999)) in view of Cameraworld.²

Applicant's invention is a method and system for providing photographic products and/or services comprising choosing a camera from a selection of cameras, selecting a service plan or product from a menu, associating the selected camera with the selected plan or product to create an account, and entering the account into a database to maintain a record of products or services to be provided in accordance with the selected plan.

Ricoh is evidence that Applicant's method and system were publicly known, and in use, before the date of invention. Ricoh expressly discloses selecting a camera (p. 1, lines 18-20), associating the selected camera with a service plan to create an online account (p. 1, lines 5-6; and p. 2, lines 2-4), and entering account information into a database to maintain a record of products or services to be provided (p. 1, line 8).

Note that the attached "Club Photo" Web pages serve as extrinsic evidence that Ricoh relied on the claimed selecting "from a menu of photographic product and/or

² <http://web.archive.org/web/19970414000034/http://www.cameraworld.com/index.html>

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photographic service plans" (e.g. claim 1). Ricoh states that the service that is packaged with its camera is provided through a "Club Photo" membership. The attached Club Photo Web pages show that the service mentioned in Ricoh required members to choose between a standard and upgraded membership. Thus, Applicants' selecting "from a menu of photographic product and/or photographic service plans" was known and in public use as part of Ricoh's method.

Ricoh and Club Photo do not establish that selecting a camera from "among a selection of cameras" (e.g. claim 1) was publicly known and/or used. However, Cameraworld shows that at the time of Applicant's invention, the Internet was being used to offer consumers an online camera catalog (i.e. a selection of cameras). Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Ricoh to include Cameraworld's online selection of cameras. This combination would allow Ricoh's to market its camera over the Internet.

Note that the Club Photo Web page with the heading "FREE Membership for Everyone" serves as extrinsic evidence that the following were publicly known and/or used:

storing a digital record for a predetermined period of time (*n.b.*: Club Photo recycles Web pages after a predetermined period of time); and

providing an image product (*n.b.*: Club Photo sells "photo finishing products personalized with your favorite photots").

Ricoh discloses updating the product/service plan account as claimed. This is because as users upload pictures to the Club Photo server, their personalized Web pages (i.e. Web accounts) are updated to reflect the change.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink (Frink, S. "Ocean Divers; a full service dive resort on the shores of Pennekamp

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Park” Skin Diver (August, 1985) Vol. 34, p. 102) in view of “Promo” (Creative Gallery: ‘Olympus Camera Craze”” Promo (September 1994)) and Safai et al. (US 6,167,469).

Frink teaches a method of providing photographic products and/or service, comprising:

selecting a camera among a selection of cameras (p. 1, lines 8, 16 and 19);

selecting a photographic service plan from a menu of plans (p. 1, lines 8-9, 17-22;

associating the selected camera with the selected photographic product to create an account (p. 1, lines 8-9, 17-22);

wherein the selected camera is provided for a predetermined period of time for a predetermined fee (p. 1, lines 16).

Frink does not expressly teach entering a user’s account information into a database. However, one skilled in the art of renting camera equipment would recognize that greater organization and information access could be gained by electronically storing transaction information. Therefore, at the time of Applicant’s invention, it would have been obvious to one of ordinary skill in the art, to modify Frink to include entering the user’s transaction information into a database.

Note that Frink does not expressly teach providing film development for a predetermined number of rolls of film. However, Promo teaches promoting the sale of a camera by offering free film developing for a predetermined number of rolls of film. At the time of Applicant’s invention, it would have been obvious to one of ordinary skill in the art, to modify Frink to include providing film development for a predetermined number of rolls of film as this combination would encourage consumers to rent Frink’s cameras.

Frink and Promo do not expressly teach automatically access a computer database when images are received from a digital camera. However, Safai et al. overcome this deficiency by disclosing the automatic distribution of digital images to a remote server (see e.g. col. 13, lines 39-46; and col. 14, lines 9-24). Note that Safai et al. suggest combining

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this automatic distribution feature with the teachings of Frink and Promo in that Safai et al. disclose distributing digital images in connection with the maintenance of a photo album. Therefore, at the time of Applicants' invention, it would have been obvious to modify Frink and Promo to include the teachings of Safai et al.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink (Frink, S. "Ocean Divers; a full service dive resort on the shores of Pennekamp Park" Skin Diver (August, 1985) Vol. 34, p. 102) in view of "Promo" (Creative Gallery: 'Olympus Camera Craze'" Promo (September 1994)).

Frink teaches a method of providing photographic products and/or service, comprising:

selecting a camera among a selection of cameras (p. 1, lines 8, 16 and 19);

selecting a photographic service plan from a menu of plans (p. 1, lines 8-9, 17-22;

associating the selected camera with the selected photographic product to create an account (p. 1, lines 8-9, 17-22);

wherein the selected camera is provided for a predetermined period of time for a predetermined fee (p. 1, lines 16).

Frink does not expressly teach entering a user's account information into a database. However, one skilled in the art of renting camera equipment would recognize that greater organization and information access could be gained by electronically storing transaction information. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink to include entering the user's transaction information into a database.

Note that Frink does not expressly teach providing film development for a predetermined number of rolls of film. However, Promo teaches promoting the sale of a camera by offering free film developing for a predetermined number of rolls of film. At the

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time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink to include providing film development for a predetermined number of rolls of film as this combination would encourage consumers to rent Fink's cameras.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink in view of Promo and "Film Processors" ("Film Processors Deliver Snapshots Electronically To Your Computer" Orange County Register (March 4, 1997)) and Safai et al. (US 6,167,469).

Frink, Promo and Safai et al. teach all the limitations noted above. Frink, Promo and Safai et al. do not expressly teach scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. However, Film Processors discloses scanning images to create a disk of images, transmitting images to designated recipients, and storing the images for a predetermined period of time (p. 1, lines 3-5, 9 and 13-14). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink, Promo and Safai et al. to include Film Processors' scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. This combination would enable the skilled artisan to offer a wider range of photographic services thereby increasing demand.

Note that even if Frink, Promo, Safai et al. and Film Processors did not teach "storing said digital record for *a predetermined period of time*," it would have been obvious to include this feature. This results for at least two reasons. First, the skilled artisan would recognize that perpetually maintaining a Web page for every customer would result in the wasting of storage space on delinquent accounts. Second, storing a digital record for a predetermined period of time would enable the skilled artisan to offer an online subscription service for a fee. Thus, one of ordinary skill would have been motivated to make the stated combination.

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Claims 17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink in view of Promo and "Film Processors" ("Film Processors Deliver Snapshots Electronically To Your Computer" Orange County Register (March 4, 1997)).

Frink and Promo teach all the limitations noted above. Frink and Promo do not expressly teach scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. However, Film Processors discloses scanning images to create a disk of images, transmitting images to designated recipients, and storing the images for a predetermined period of time (p. 1, lines 3-5, 9 and 13-14). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink and Promo to include Film Processors' scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. This combination would enable the skilled artisan to offer a wider range of photographic services thereby increasing demand.

Note that even if Frink, Promo and Film Processors did not teach "storing said digital record for a *predetermined period of time*," it would have been obvious to include this feature. This results for at least two reasons. First, the skilled artisan would recognize that perpetually maintaining a Web page for every customer would result in the wasting of storage space on delinquent accounts. Second, storing a digital record for a predetermined period of time would enable the skilled artisan to offer an online subscription service for a fee. Thus, one of ordinary skill would have been motivated to make the stated combination.

Claims 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricoh in view of Cameraworld, "PhotoAccess.com" ("New sites offer prints from digital cameras" Photo Marketing Newsline (December 15, 1999)) and Safai et al. (US 6,167,469).

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With respect to claim 9, Ricoh, Cameraworld and Safai et al. teach all the limitations discussed above. Ricoh, Cameraworld and Safai et al do not expressly teach providing a predetermined number of prints of images from the selected camera. However, PhotoAccess.com discloses a promotion wherein digital camera users are provided with 5 free prints. At the time of Applicant's invention, it would have been obvious to one of ordinary skill, to modify Ricoh, Cameraworld and Safai et al. to include providing a predetermined number of prints as taught by PhotoAccess.com in order to promote camera sales.

Regarding claims 10 and 12, Ricoh, Cameraworld and Safai et al. do not expressly teach wherein the selected camera is a film camera. However, PhotoAccess.com teaches providing an online film service wherein consumers use a scanner to printed images to an online service, wherein the online service uses the images to create an online photoalbum, or provide additional prints. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify , Ricoh, Cameraworld and Safai et al. to include the teachings of PhotoAccess.com. Such a combination would provide a wider range of image service options thereby improving customer satisfaction and establishing goodwill.

Claims 16, 25-27 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricoh in view of Cameraworld and "PhotoAccess.com" ("New sites offer prints from digital cameras" Photo Marketing Newsline (December 15, 1999)).

Ricoh and Cameraworld do not expressly teach wherein the selected camera is a film camera. However, PhotoAccess.com teaches providing an online film service wherein consumers use a scanner to printed images to an online service, wherein the online service uses the images to create an online photoalbum, or provide additional prints. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Ricoh and Cameraworld to include the teachings of PhotoAccess.com. Such a combination

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would provide a wider range of image service options thereby improving customer satisfaction and establishing goodwill.

Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricoh in view of Cameraworld, PhotoAccess.com and Film Processors ("Film Processors Deliver Snapshots Electronically To Your Computer" Orange County Register (March 4, 1997)).

Ricoh, Cameraworld, PhotoAccess.com, Promo teach all the limitations noted above. Frink and Promo do not expressly teach scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. However, Film Processors discloses scanning images to create a disk of images, transmitting images to designated recipients, and storing the images for a predetermined period of time (p. 1, lines 3-5, 9 and 13-14). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frink and Promo to include Film Processors' scanning film to create a digital record, placing the digital record on a disk, and/or forwarding the images to a recipient. This combination would enable the skilled artisan to offer a wider range of photographic services thereby increasing demand

Response to Arguments

Applicants argue that neither Ricoh, Cameraworld nor Frink teach or suggest setting up an account by a service provider with respect to goods and/or services to be received. The Examiner respectfully disagrees. Ricoh teaches setting up an account by disclosing an arrangement wherein a merchant provides online photography services to a buyer in exchange for the buyer's purchase of particular camera. This requires setting up an account because the merchant could not

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possibly identify the buyer as being entitled to free service unless some record of the original transaction is maintained. It should be noted that the account relates to goods and services that are "to be received" in that the above-mentioned arrangement is made before any online services are provided.

Applicants also urge that neither Ricoh, Cameraworld nor Frink teach or suggest a predetermined account plan or service plan for providing goods or services. The Examiner respectfully disagrees in that this feature is disclosed through Ricoh's bundling of photography services with a camera purchase. As noted above, Ricoh discloses an arrangement wherein a merchant provides online photography services in exchange for the purchase of a camera. Ricoh provides that the merchant "gives users the ability to publish entire photo albums onto their own personal Web sites, free of charge." Thus, the photography services that are "to be received" are determined at the time the buyer purchases the camera. Ricoh therefore discloses a predetermined account plan.

Applicants argue neither Ricoh, Cameraworld nor Frink teach or suggest a relationship between a particular camera and a particular service plan or account that is stored on a database. That is, the references fail to teach or suggest associating a particular camera with a service plan in a database. The Examiner respectfully submits that Ricoh meets this limitation through its discussion of "Club Photo." "Club Photo" is a free, personalized Web page service (i.e. service plan) that is provided in connection with the purchase of a selected camera. It is clear that this Web page service is associated with the selected camera because access to the service is predicated on the purchase of the buyer-selected camera. Note that Ricoh's service plan/account is stored in a database. This results because offering a

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personalized Web page service requires associating a user with a file having the user's personalized data. Based on at least this disclosure, Ricoh teaches a relationship between a particular camera and a particular service plan or account that is stored in a database.

Applicants argue neither Frink nor Promo teach or suggest providing service plans or product plans with respect to images captured by a particular camera. However, Frink discloses a service that rents underwater cameras for diving excursions. A camera must be selected in order for it to be rented. Offering camera rentals is a service and not a transaction for the purchase of a product. Thus, offering cameras for rent involves selecting a camera as well as a service plan (i.e. rental terms) that govern the use of the camera. Based on its disclosure of camera rentals, Frink teaches providing service plans or product plans with respect to images captured by a particular camera.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy M. Brown
Examiner
Art Unit 1648

tmb

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7/1/05


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